REMARKS

Claims 1-21 are pending in the application.

Claims 1-21 have been rejected.

Claims 8 and 11 have been amended as set forth herein.

Reconsideration of the claims is respectfully requested.

I.   CLAIM REJECTION UNDER 35 U.S.C. § 112

Claims 8-14 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Applicants have amended Claims 8-14 as shown above.

There are two separate requirements under 35 U.S.C. § 112, second paragraph. MPEP § 2171, p. 2100-209 (8th ed., rev. 5, August 2006). The first is subjective and requires that the claims must set forth the subject matter that the *Applicants* regard as their invention. *Id.* The second is objective and requires that the claims must particularly point out and distinctively define the metes and bounds of the subject matter that will be protected by the patent grant (*i.e.*, whether the scope of the claim is clear to one of ordinary skill in the art). *Id.* at 2100-210. The Examiner should explain whether the rejection is based on indefiniteness or on the failure to claim what the Applicants regard as their invention. *Id. (citing Ex parte Ionescu*, 222 U.S.P.Q. 537, 539 (Bd. App. 1984)).

Applicant thanks the Examiner for noting the mistakenly-missing transition word "comprising" and corresponding colon. These errors have been corrected above, and entry of these amendments is respectfully requested.

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With regard to the "configured to" language, Applicant respectfully notes that this is the very common way to claim a device that is particularly configured or adapted to perform certain functions, and that a generic general-purpose computer system cannot be said to be "configured" to perform the claimed functions. Those of skill in the art are surely apprised of the claim scope, with no ambiguity at all. However, if the Examiner believes some other language would be appropriate, Applicant would be happy to receive and consider any suggestions.

Accordingly, the Applicants respectfully request the Examiner to withdraw the § 112 rejection.

II.   CLAIM REJECTION UNDER 35 U.S.C. § 103

Claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,112,225 to *Kraft, et al.*, hereinafter "Kraft" and U.S. Patent No. 6,360,268 to *Silva, et al.*, hereinafter "Silva". The Applicants respectfully traverse the rejection.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. (*Id.* at 1073, 5 USPQ2d at 1598). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these

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factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Absent such a prima facie case, the applicant is under no obligation to produce evidence of nonobviousness. MPEP § 2142, p. 2100-125 (8th ed. rev. 5, August 2006). To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id*. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id*. Second, there must be a reasonable expectation of success. *Id*. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id*.

Claim 1 requires receiving a test request. The Examiner argues that this is taught a Kraft at col. 9, lines 1-27. This portion of Kraft was reproduced in a previous response, and of course does not teach or suggest receiving a test request at all. Kraft does teach that a subtask request is sent to coordinating computer 102 (which, of course, receives it).

Claim 1 also requires sending executable program code, corresponding to the test request, to a client system. Kraft appears to teach that a subtask is then received by peripheral computer 106, which may have been sent by the coordinating computer 102.

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Claim 1 also requires receiving a response from the client system indicating that the client system will perform a test, and indicating that the client system was not being actively used when the executable program code was sent. This is <u>not</u> taught or suggested by Kraft. The Examiner refers again to the passage reproduced again, but it is clear that coordinating computer 102 does not receive any sort of response indicating that the peripheral computer will perform a subtask, nor does coordinating computer 102 receive any sort of response indicating that the peripheral computer was not being actively used when the subtask was sent.

The Examiner responds by again referring to the col. 9 passage, and stating

> The system of Kraft on sends [*sic*] indications to the server (in the
>
> form of requesting new tasks and sending result of previous tasks)
>
> when it is otherwise not being actively used (see decision block 608
>
> in Figure 6 (checking if the client system is idle)).

The Examiner is correct in that task requests and results are sent when the system is idle – but this is not the claim limitations. There is no response sent from the client to server indicating that the client <u>will</u> perform a task that it has been sent, as claimed – there appears to be no confirmation at all that a subtask has been received, or that the client will execute it. Nor is there any response sent from the client to server indicating that the client was not being actively used when the subtask was sent – it may have been idle when the task was originally requested, and it may be idle again at some point when the task is completed, but there is no indication that the client is idle when the subtask is received.

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This can be important, of course, when the server must determine how soon a task is to be completed – in Kraft's system, there is no indication at all of when the task may be executed or completed. On the other hand, the claimed method provides that when the code is received by the client, it responds with an indication that it was idle on receipt and it will execute the task (perform the test). This is significantly different than the system of Kraft, and is not taught or suggested by Kraft.

Kraft does not teach or suggest this limitation of claim 1. Nor does Silva, nor does the Examiner allege any such teaching in Silva.

None of the cited references teach or suggest this limitation of claim 1, alone or in combination, or the similar limitations of claims 8 and 15. The rejections, therefore, of claims 1-3, 8-10, and 15-17 are traversed.

Claim 4 requires receiving executable code from a server system in a client data processing system. The Examiner again refers to Kraft's col. 9, lines 1-27, reproduced above. Kraft does teach that a "subtask" is received by peripheral computer 106. Though not specified, it may be from coordinating computer 102.

Claim 4 also requires if the client data processing system is in an idle state when the executable code is received, then sending a response to the server system, testing at least a portion of the executable code, and sending test results to the server system. The Examiner again refers to Kraft's col. 9, but Kraft does <u>not</u> teach or suggest this limitation. There is no response sent to the coordinating computer upon receipt of the subtask, whether or not the peripheral computer is idle when the subtask is received. Nor does Silva teach this limitation.

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Contrast the limitation of Claim 5, which requires that if the client data processing system is not in an idle state when the executable code is received, then no response is sent to the server and no testing is performed. This is also contrary to Kraft, which does not address the state of the client when the subtask is received, but will certainly execute the task and send a result whenever it does become idle.

None of the cited references teach or suggest this limitation of claim 4, alone or in combination, or the similar limitations of claims 11 and 18. The rejections, therefore, of claims 4-7, 11-14, and 18-21 are traversed.

Accordingly, the Applicants respectfully request the Examiner to withdraw the § 103 rejection with respect to these claims.

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CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.
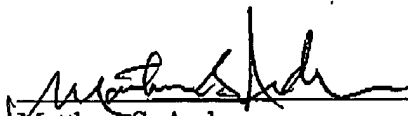
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK CARTER P.C.

Date: ___5/20/8___

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